



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911
7590 DAVID L. MCCOMBS HAYNES & BOONE LLP 901 MAIN STREET SUITE 3100 DALLAS, TX 75202-3789			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 02/21/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2
3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* DAVID S. SPRINGER and BRIAN T. ZUCKER
9

10 Appeal 2007-4207
11 Application 09/313,436
12 Technology Center 3600
13
14

15
16 Decided: February 21, 2008
17

18
19 Before JENNIFER D. BAHR, ANTON W. FETTING, and STEVEN D.A.
20 McCARTHY, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23 STATEMENT OF CASE

24 David S. Springer and Brian T. Zucker (Appellants) seek review under
25 35 U.S.C. § 134 of a Final rejection of claims 1, 4-6, 8, 9, and 26-31, the only
26 claims pending in the application on appeal.

27 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

1 We AFFIRM.

2 The Appellants invented an advertising scheme that allows a computer user to
3 benefit from viewing banner advertising by providing incentives for information
4 transmitted to and from a computer server (Specification 2:12-15).

5 An understanding of the invention can be derived from a reading of exemplary
6 claims 1, 8 and 26, which are reproduced below [bracketed matter and some
7 paragraphing added].

8 1. A method of tracking information provided to a computer system
9 from an advertisement database and a server accessed by a computer
10 manufacturer, the method comprising:

11 [1] providing an identifier unique to the computer system, the
12 identifier being imbedded in one of the computer hardware and
13 firmware in the computer system;

14 [2] the database associating the identifier with information specific to
15 a computer user associated with the computer system;

16 [3] the computer user establishing a web connection with the server
17 and transmitting the identifier to the database;

18 [4] the user logging on to a combination advertisement broker server;

19 [5] the computer system transmitting the identifier and requesting that
20 a banner advertisement be displayed on the computer system;

21 [6] the database checking for the identifier;

22 [7] a counter accounting for the presence of the identifier; and

23 [8] based on the number of times the database locates the identifier,
24 the database:

- 1 determining which advertisements have been transmitted to the
2 user; and
3 based on the computer user associated with the identifier
4 receiving a predetermined number of advertisements in a
5 time period,
6 the computer user associated with the identifier:
7 receiving discounts on advertised computer
8 components from the manufacturer.
- 9 8. The method of Claim 1 wherein the identifier is one of
10 a system code,
11 a system code stored in nonvolatile memory,
12 a unique ID from a microprocessor,
13 a unique ID from a peripheral device and
14 a unique identifier stored on a hard drive.
- 15 26. A method for tracking information to a computer system from a
16 server accessed by a computer manufacturer comprising:
17 [1] providing an identifier unique to the computer system;
18 [2] providing a database associating the identifier with information
19 specific to a computer user;
20 [3] the user logging on to a combination advertisement broker server;
21 [4] the computer system transmitting the identifier and requesting that
22 a banner advertisement be displayed on the computer system;
23 [5] the database checking for the identifier;
24 [6] a counter accounting for the presence of the identifier; and
25 [7] based on the number of times the database locates the identifier,
26 the database;
27 determining which advertisements have been transmitted to the
28 user; and

1 based on the computer user associated with the identifier
2 receiving a predetermined number of advertisements in a time
3 period,

4 the computer user associated with the identifier:

5 receiving discounts on advertised computer components
6 from the manufacturer.

7 This appeal arises from the Examiner's Final Rejection, mailed July 20, 2005.

8The Appellants filed an Appeal Brief in support of the appeal on April 27, 2006.

9An Examiner's Answer to the Appeal Brief was mailed on July 17, 2006. A Reply
10Brief was filed on September 13, 2006.

11 PRIOR ART

12 The Examiner relies upon the following prior art:

Marsh	US 5,848,397	Dec. 8, 1998
Guyot	US 6,119,098	Sep. 12, 2000
Jenkins	US 6,285,983 B1	Sep. 4, 2001

13 REJECTIONS

14 Claims 1, 4, 5, 8, 9, 26-28, 30, and 31 stand rejected under 35 U.S.C. § 103(a)
15as unpatentable over Guyot and Jenkins.

16 Claims 6 and 29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over
17Guyot, Jenkins, and Marsh.

18 ISSUES

19 The issues pertinent to this appeal are

- 1 • Whether the Appellants have sustained their burden of showing that the
 2 Examiner erred in rejecting claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35
 3 U.S.C. § 103(a) as unpatentable over Guyot and Jenkins.
- 4 • Whether the Appellants have sustained their burden of showing that the
 5 Examiner erred in rejecting claims 6 and 29 under 35 U.S.C. § 103(a) as
 6 unpatentable over Guyot, Jenkins, and Marsh.
- 7 The pertinent issues turn on whether the art describes or suggests using an
 8 identifier imbedded in one of the computer hardware and firmware in the computer
 9 system.

10 FACTS PERTINENT TO THE ISSUES

11 The following enumerated Findings of Fact (FF) are believed to be supported
 12 by a preponderance of the evidence.

13 *Facts Related to Claim Construction*

- 14 1. The disclosure contains no lexicographic definition of “imbed.”
- 15 2. The ordinary and customary meaning of “imbed” is to fix firmly, enclose
 16 snugly, or cause to be an integral part.¹

17 *Facts Related to Appellants’ Disclosure*

- 18 3. The Specification describes storing an identifier on a hard drive
 19 (Specification 5:15-18).

20 *Guyot*

10¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

4. Guyot is directed to targeting and distributing advertisements over a distributed information network, such as the internet. Guyot provides a client application that runs on a subscriber's computer and a server that manages an advertisement database and that provides advertisements to the client application that are targeted to each individual subscriber, based on a personal profile provided by that subscriber (Guyot 1:56-65).
5. Guyot exchanges information between the server and the subscriber system, with the server and each of the subscriber systems having a unique identifier (Guyot 3:17-22).
6. Guyot's processor assigns credits to the subscriber based on the number of advertisements the subscriber has been exposed to. This information may then be used to provide remuneration to the subscriber based on the number of advertisements displayed on the subscriber system. A total credit amount indicator presents the number of credits the subscriber has earned over a predetermined period of time. The processor sends the total credit amount information to the server when a connection is established with the server (Guyot 6:6-16).
7. Guyot's Subscriber Statistics are valid for a predetermined period of time (Guyot 6:50-51).

Jenkins

8. Jenkins is directed to a marketing system for directing customized offers to consumers that includes a classes database derived from an

abstraction of the individual records database and second communications facilities that provide access by marketers to the marketing server (Jenkins 2:55-65).

9. Jenkins describes in background that data-driven marketing in general and direct marketing in particular have increasingly taken advantage of expanded electronic marketing, including, for example, offerings directed to individuals through e-mail accounts and the use of web browser cookie files to target web page banner ads. As is known in the art, cookie files² may be installed by a web site server on the computer hard disk drive of a browsing consumer.

Facts Related To Differences Between The Claimed Subject Matter And The Prior Art

10. One of ordinary skill knew that computer manufacturers advertised and promoted their products, including computer components.
11. One of ordinary skill knew that discounts were a widely used and predictable form of product promotion.

Facts Related To The Level Of Skill In The Art

12. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of tracking items and data formatting. We will therefore consider the cited prior art as representative of the

¹⁵² As is well known, “[a] cookie is arbitrary data that a server provides to a browser in order to uniquely identify that user upon subsequent access to the server.”
¹⁶ (Douglis, US 6,249,795 B1, Jun. 19, 2001, col. 2, ll. 8-10)

level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 807 F.2d 955, 963 (Fed. Cir. 1985)).

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 2347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such

1 definitions in the Specification with sufficient clarity to provide a person of
 2 ordinary skill in the art with clear and precise notice of the meaning that is to be
 3 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
 4 an inventor is free to define the specific terms used to describe the invention, this
 5 must be done with reasonable clarity, deliberateness, and precision; where an
 6 inventor chooses to give terms uncommon meanings, the inventor must set out any
 7 uncommon definition in some manner within the patent disclosure so as to give
 8 one of ordinary skill in the art notice of the change).

9 *Obviousness*

10 A claimed invention is unpatentable if the differences between it and the
 11 prior art are “such that the subject matter as a whole would have been obvious at
 12 the time the invention was made to a person having ordinary skill in the art.”
 13 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);
 14 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

15 In *Graham*, the Court held that that the obviousness analysis is bottomed on
 16 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
 17 determined; [(2)] differences between the prior art and the claims at issue are to be
 18 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
 19 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
 20 combination of familiar elements according to known methods is likely to be
 21 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

22 “When a work is available in one field of endeavor, design incentives and
 23 other market forces can prompt variations of it, either in the same field or in a

1different one. If a person of ordinary skill in the art can implement a predictable
2variation, § 103 likely bars its patentability.” *Id.* at 1740.

3 “For the same reason, if a technique has been used to improve one device,
4and a person of ordinary skill in the art would recognize that it would improve
5similar devices in the same way, using the technique is obvious unless its actual
6application is beyond his or her skill.” *Id.*

7 “Under the correct analysis, any need or problem known in the field of
8endeavor at the time of invention and addressed by the patent can provide a reason
9for combining the elements in the manner claimed.” *Id.* at 1742.

10 ANALYSIS

11 *Claims 1, 4, 5, 8, 9, 26-28, 30, and 31 rejected under 35 U.S.C. § 103(a) as*
12 *unpatentable over Guyot and Jenkins.*

13 The Appellants argue these claims as a group.

14 Accordingly, we select claim 26 as representative of the group.

1537 C.F.R. § 41.37(c)(1)(vii) (2007).

16 The Examiner found that Guyot described all of the limitations of claim 26,
17except those of having the party accessing the server be a computer manufacturer,
18and having the discounts be associated with computer components from the
19manufacturer. The Examiner implicitly found that such a computer manufacturer
20would have been a predictable advertiser in Guyot’s system, and that discounts on
21what the manufacturer sold would be predictable species of Guyot’s credits with
22such an advertiser. The Examiner further found, as to the claims additionally

1 requiring an imbedded identifier as with claim 1, that Jenkins described an
 2 example of an imbedded identifier as a cookie (Answer 3-6).

3 The Appellants contend that Jenkins' cookie does not contain an identifier
 4 imbedded in a system hardware or software component during manufacture (Br.
 5 11:Fourth ¶), and that Guyot does not describe a computer manufacturer and
 6 discounts by such a manufacturer (Br. 11:Fifth ¶). The Appellants further argue
 7 that neither Guyot nor Jenkins describes the desirability of the combination
 8 because, in particular, cookies are undesirable in such a combination (Br. 12).

9 We disagree. As to whether either reference describes computer manufacturers
 10 as advertisers or discounts on computer components, or suggests the desirability of
 11 the combination of the references,

12 [t]he obviousness analysis cannot be confined by a formalistic
 13 conception of the words teaching, suggestion, and motivation, or by
 14 overemphasis on the importance of published articles and the explicit
 15 content of issued patents. The diversity of inventive pursuits and of
 16 modern technology counsels against limiting the analysis in this way.
 17 In many fields it may be that there is little discussion of obvious
 18 techniques or combinations, and it often may be the case that market
 19 demand, rather than scientific literature, will drive design trends.

20 *KSR*, 127 S. Ct. at 1741. Further,

21 When a work is available in one field of endeavor, design incentives
 22 and other market forces can prompt variations of it, either in the same
 23 field or a different one. If a person of ordinary skill can implement a
 24 predictable variation, § 103 likely bars its patentability.

25 *id.* at 1740. Guyot distributes advertisements using a client application that
 26 runs on a subscriber's computer and a server that manages an advertisement

1 database and that provides advertisements to the client application that are targeted
2 to each individual subscriber, based on a personal profile provided by that
3 subscriber (FF). As pointed out by the Examiner (Answer 5), a computer
4 manufacturer is a predictable embodiment of Guyot's advertiser, whose advertising
5 would be driven by market forces.

6 Guyot assigns credits to its subscriber based on the number of advertisements
7 the subscriber has been exposed to. This information may then be used to provide
8 remuneration to the subscriber based on the number of advertisements displayed on
9 the subscriber system. A total credit amount indicator presents the number of
10 credits the subscriber has earned over a predetermined period of time (FF). We
11 find that discounts are a predictable embodiment of Guyot's remuneration since a
12 discount is a widely practiced form of promotion, again driven by market forces.
13 We further find that such discounts would likely pertain to items or services sold
14 by the discounter for the simple reason that discounts are with respect to sales,
15 which in the case of a computer manufacturer would include computer
16 components.

17 The remaining arguments by the Appellants regarding the limitation of
18 imbedding an identifier are moot with respect to claim 26, because claim 26 is a
19 method claim and contains no structural limitation regarding the imbedding of an
20 identifier. Thus, the Appellant has not sustained its burden of showing that the
21 Examiner erred in rejecting claims 26-28, 30, and 31.

22 Although the Appellants argued the claims as a group and we have found the
23 Appellants have not sustained their burden as to representative claim 26, we will

1address the Appellants' arguments in support of claim 1. To do so, we must next
2construe the limitation "identifier being imbedded in one of the computer hardware
3and firmware in the computer system." The word "imbed" is not lexicographically
4defined by the disclosure. The common meaning of the verb "imbed" within the
5context of an item of data such as an identifier is "to fix firmly" (FF &).
6Therefore we construe the limitation of "identifier being imbedded in one of the
7computer hardware and firmware in the computer system" as "identifier being
8fixed firmly in one of the computer hardware and firmware in the computer
9system."

10 Guyot describes relying on a unique identifier (FF). Jenkins describes one
11technique for providing such an identifier, a cookie, as a data element stored on a
12hard drive (FF). Thus the issue becomes whether storing an identifier as a cookie
13on a hard drive provides an identifier fixed firmly in one of the computer hardware
14and firmware in the computer system. We find that the Appellants' disclosure
15describes storing an identifier on a hard drive (FF) and that claim 8, which
16depends from claim 1, embraces an embodiment including an identifier stored on a
17hard drive. Thus, the Appellants' disclosure supports construing the scope of
18claim 1 to include identifiers stored on a hard drive and claim 8 requires that the
19scope of claim 1 be broad enough to encompass an identifier stored on a hard
20drive.

21 We now turn to the Appellants' argument that cookies present well known
22problems, *viz.* cookies do not automatically identify the client computer's owner to
23enable advertising revenue sharing; do not automatically allow any correlation

1between the computer's owner and his individual preferences for targeted
 2advertising; and are lacking in desirable security features because they can be
 3easily altered, deleted, disabled or copied to multiple computers (Br. 12). We find
 4that whether such problems exist is moot because claim 1 does not require
 5identifying the computer's owner, or a correlation between the computer's owner
 6and the owner's preferences, or any security features.

7 The Appellants have not sustained their burden of showing that the Examiner
 8erred in rejecting claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35 U.S.C. § 103(a) as
 9unpatentable over Guyot and Jenkins.

10 *Claims 6 and 29 rejected under 35 U.S.C. § 103(a) as unpatentable over Guyot,*
 11 *Jenkins, and Marsh.*

12 The Appellants have relied upon the arguments for the patentability of claim 1,
 13*supra*, which we found to be insufficient to meet the Appellants' burden.
 14Therefore, the Appellants have not sustained their burden of showing that the
 15Examiner erred in rejecting claims 6 and 29 under 35 U.S.C. § 103(a) as
 16unpatentable over Guyot, Jenkins, and Marsh.

17 CONCLUSIONS OF LAW

18 The Appellants have not sustained their burden of showing that the Examiner
 19erred in rejecting claims 1, 4-6, 8, 9, and 26-31 under 35 U.S.C. § 103(a) as
 20unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 4, 5, 8, 9, 26-28, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Guyot and Jenkins is sustained.
 - The rejection of claims 6 and 29 under 35 U.S.C. § 103(a) as unpatentable over Guyot, Jenkins, and Marsh is sustained.
- No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JRG

17

DAVID L. MCCOMBS
HAYNES & BOONE LLP
20901 MAIN STREET
SUITE 3100
DALLAS, TX 75202-3789